

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

As set forth in paragraph 3 on page 2 of the October 3 Office Action, claim 43 stands rejected under 35 U.S.C. § 112, second paragraph because there is insufficient antecedent basis for the claim element “the metadata” in line 2.

As set forth in paragraph 5 on page 2 of the October 3 Office Action, claim 43 stands rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either an asserted utility or a well-established utility.

As set forth in paragraph 5 on page 4 of the October 3 Office Action, claim 43 stands rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,594,503 B1 to Herzig *et al.* (hereinafter “Herzig” or “the Herzig patent”).

As set forth in paragraph 7 on page 4 of the October 3 Office Action, claims 1, 3 – 12, 14 – 17, 22 – 23, 26 – 37 and 40 – 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view of United States Patent Application Publication No. 2002/0140993 A1 to Silverbrook (hereinafter “Silverbrook” or “the Silverbrook application”) and further in view of DE010158358351A1 to Schultheis (hereinafter “Schultheis”).

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As set forth in paragraph 8 on page 12 of the October 3 Office Action, claims 13 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzog patent in view Silverbrook and Schultheis and further in view WO 99/17230 to Schlasberg (hereinafter “Schlasberg”).

As set forth in paragraph 9 on page 14 of the October 3 Office Action, claims 24 – 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzog patent in view Silverbrook and Schultheis and further in view of United States Patent No. 6,707,581 to Browning (hereinafter “Browning”).

As set forth in paragraph 10 on page 15 of the October 3 Office Action, claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Herzog in view of Silverbrook and Schultheis and further in view of United States Patent No. 6,741,864 B2 to Wilcock et al. (hereinafter “Wilcock” or “the Wilcock patent”).

II. Applicant’s Response – Claim Rejections

A. Rejection of Claim 43 under 35 U.S.C. § 112, second paragraph

Applicant has amended claim 43, thereby mooting the rejection of the claims on this basis. Applicant therefore respectfully requests that the rejection of claim 43 on this basis be withdrawn.

B. Rejection of Claim 43 under 35 U.S.C. § 101

Applicant has made a number of amendments to claim 43 which more clearly establish that the metadata incorporated in the document includes a machine-readable and –executable instruction that is configured to operate an electronic device when executed. Accordingly, it is not merely a collection of descriptive material. The MPEP has this to say about claims of this sort:

“Descriptive material can be characterized as either ‘functional descriptive material’ or ‘nonfunctional descriptive material.’ In this context, ‘functional descriptive material’ consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of ‘data structure’ is ‘a physical or logical relationship among data elements, designed to support specific data manipulation functions.’ The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) ‘Nonfunctional descriptive material’ includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of ‘descriptive material’ are nonstatutory when claimed as descriptive material per se 33 F. 3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized ...”

Accordingly, in view of the foregoing amendments and this portion of the MPEP, claim 43 is seen to have utility. Accordingly, Applicant respectfully requests that the rejection of claim 43 on this basis be withdrawn.

C. Rejection of Claim 43 under 35 U.S.C § 102(e)

In view of the clarifying amendments to claim 43, Applicant respectfully submit that the rejection of this claim on the basis of Herzog cannot be maintained. Specifically, the instruction is machine-executable and configured to operate an electronic device when executed. The relied-upon and remaining portions of Herzog simply neither describe nor suggest this subject matter of claim 43. In particular, the telephone number of Herzog is at best data used by an instruction to perform a telephone call, but is not an instruction to place a telephone call. As anyone that is familiar with operation of wireless telephones knows, the mere entry of a telephone number does not cause a telephone to place a call. Rather, once the number has been entered, the device must be programmed either to automatically place the call, or to place the call in response to a specific user input. In these and other related cases, it cannot be said that a telephone number is an instruction. At best, it is data, or an argument, that an instruction operates on to perform a function. Applicant therefore respectfully requests that the rejection of claim 43 on this basis be withdrawn.

D. Rejections under 35 U.S.C § 103(a)

Applicant reproduces claim 1 (as amended) here as a convenience to the Examiner (emphasis added):

1. An electronic device comprising:
data reading means operable to read metadata carried by an image carrier which carries a printed image;

interpretation means operable to interpret the metadata to identify an instruction for operation of the device;

execution means operable to cause the device to execute an instruction identified by the interpretation means; and

an image system comprising:

image means operable to receive data representing an image;

metadata means operable to generate metadata able to be interpreted to identify an instruction of the electronic device, and to associate the metadata with the image data; and

data output means operable to output image data and associated metadata for generating a printed image which incorporates the metadata in a form readable by the electronic device,

where the electronic device is a hand portable electronic device.

Claim 1 is patentable over the art of record, whether taken singly or in combination, because the art of record does not teach each and every limitation of claim 1. In particular, it is not seen where in the combination of Herzig, Silverbrook and Schultheis there is either a description or suggestion of the emphasized subject matter of claim 1.

Herzig as admitted in the October 3 Office Action does “not specifically teach of comprising printer means operable to receive data representing an image and associated metadata, and to generate a printed image” (page 5, lines 19 – 2). As a result in an effort to remedy this deficiency of Herzig the Examiner relies upon Silverbrook which purportedly teaches “of comprising printer means operable to receive data representing

an image and associated metadata, and to generate a printed image, which incorporates the metadata" (paragraph 4 and 44 and claim 16). However, the relied-upon portions of Silverbrook (reproduced here) simply do not describe or suggest the emphasized subject matter of claim 1:

"It is an object of the present invention to provide a mobile phone device having an integral internal compact printer that is adapted to print information from the phone on to print media supplied from a source external to the phone device.

* * *

The phone 1 can optionally be equipped with a camera device 10 comprising lenses 11 and associated CCD chip or CMOS sensor 12. The CCD or CMOS sensor enables the device to store images on demand, so that the phone can effectively act as a camera device for the printing out of images, or for their capture and forwarding across a phone network. The operation of the relevant part of the internal control electronics can be substantially as set out in the applicant's earlier PCT application WO 99/04551 entitled "A replenishable one time camera system" the contents of which are incorporated herein by reference. In other embodiments, the camera device may also be configured to enable video conferencing by facilitating image processing during phone transmission. A camera function that is mounted for selective movable positioning on the phone device may be useful for this purpose. For example, it may be rotatable between a forward facing camera orientation and a rearward facing video conferencing orientation.

16. A mobile phone device as claimed in claim 2 further including a scanner adapted to scan printed images."

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As is evident from consideration of these portions, Silverbrook says nothing about “data output means *operable to output* image data *and associated metadata*” as is required by claim 1. In other words, and in contradistinction to the position taken by the Examiner, the relied-upon and remaining portions of Silverbrook simply do not describe or suggest the relevant subject matter of claim 1. Schultheis is not seen to remedy this deficiency of Silverbrook.

The remaining references relied upon in the rejection of the dependent claims do not remedy the deficiencies of the primary combination.

Accordingly, since the art of record neither describes nor suggests the combination of elements reflected in claim 1, Applicant submits that claim 1 is patentable and should be allowed. As a result, Applicant respectfully submits that the rejection of claim 1 be withdrawn. Applicant also submits that claims 3 – 17 and 22 – 42 are allowable both as depending, either directly or indirectly, on an allowable base claim, and for reasons having to do with their independently-recited features. Applicant therefore respectfully requests that the rejection of claims 3 – 13 and 22 – 42 be withdrawn.

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III. Conclusion

The Applicant submits that in light of the foregoing remarks and amendments the application is now in condition for allowance. Applicant therefore respectfully requests that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

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Date

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